

REMARKS

Claims 1-3, 5 and 7 are pending in this application and stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,120,255 (“Kouda”) in view of U.S. Patent No. 5,686,897 (“Loh”). Applicant respectfully requests reconsideration of the rejection in view of the following explanation.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. The Examiner must show, inter alia, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 1 recites, in relevant parts, that “the ***detection device*** is arranged on a ***chip element that is fixedly connected*** to the plug,” and that “a receiver unit . . . [is] configured to receive data from the data transmission device, wherein the receiver unit is configured to be attached to a wrist of an operator.” In support of the rejection, the Examiner contends that “it would be inherent that the chip [of Kouda] be fixedly connected to the plug for simplification of manufacturing process” because Kouda “discloses a chip associated with the plug and socket elements (see col. 5, lines 31-44).” However, nothing in the cited section of Kouda mentions anything about a chip associated with the plug and socket elements, i.e., there is no suggestion that the male connector M or the female connector F is a chip element. Furthermore, even if Kouda did disclose a chip associated with the plug and socket elements, this disclosure would have nothing to do with the claimed feature, i.e., “the ***detection device*** is ***arranged*** on a ***chip element that is fixedly connected*** to the plug,” since the only thing even remotely close to being a “detection device” in Kouda is “mark reader G” shown in Fig.

4f of Kouda (and described in associated text of col. 5, l. 31-44), which ***“mark reader G” is at a clearance distance from the plug housing in order to pick up a signal.*** Accordingly, the detection device of Kouda is not ***arranged*** on anything, let alone a chip, since the mark reader G is an independent mechanism for reading the mark m. For at least this reason, the cited section of Kouda does not teach or suggest that a ***“detection device is arranged on a chip element that is fixedly connected to the plug,”*** and the combination of the applied references fails to render claim 1 and its dependent claims 2, 3, 5 and 7 obvious.

Independent of the above, while the Examiner relies on the doctrine of inherent disclosure for the rejection, the Examiner has clearly failed to provide any “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art,” which is required in order to rely on the doctrine of inherent disclosure. “The fact that certain result or characteristic ***may occur*** or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (M.P.E.P. § 2112, citing In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993)). Clearly, the applicable law is that it is insufficient to establish inherency ***even if one could somehow show that the chip could be fixedly connected to the plug for simplification of manufacturing process.*** There is simply no plausible reason that any hypothetical “chip element” (which is not suggested in Kouda) ***would necessarily have to be fixedly connected to the plug***, which is the requirement for establishing inherent disclosure. In any case, not only is there no suggestion of a chip associated with the plug and socket elements, or that the ***“detection device is arranged on a chip element,”*** but it is also clearly shown in Fig. 4f of Kouda (and described in associated text of col. 5, l. 31-44) that “mark reader G” is at a distance from the plug housing in order to pick up a signal. Clearly, there is no suggestion that the detection device (“mark reader G”) is connected to anything, let alone a chip, and there is no suggestion that detection device is arranged on a chip element that is fixedly connected to the plug housing.

For at least the foregoing reasons, the combination of the applied references fails to render claim 1 and its dependent claims 2, 3, 5 and 7 obvious.

Independent of the above, Applicant notes that Loh clearly fails to teach or suggest the claimed features that ***“a receiver unit . . . [is] configured to receive data from the data transmission device, wherein the receiver unit is configured to be attached to a wrist of an operator.”*** First, the Examiner does not specifically identify what element of Kouda

satisfies the claimed "receiver unit" feature. To the extent the Examiner cites column 5, line 44 of Kouda as teaching the claimed feature of the receiver unit including a memory (as recited in claim 7), Applicant notes that this cited section of Kouda merely indicates that "locking of the electric connector are confirmed by reading the mark m of the complete locking detecting slider S." To the extent the Examiner may be contending that the mark reader G may somehow satisfies the "receiver unit" feature, Applicant notes that this contention is entirely contradictory to the Examiner's other assertion that mark reader G is equivalent to the "detection device including an analyzer device and a data transmission device." More particularly, although the Examiner contends that Loh provides a motivation to modify the teachings of Kouda so as to attach the receiver unit to a wrist, this asserted modification doesn't make any sense because: a) Loh has nothing to do with a **receiver**; and b) if the mark reader G is assumed to be equivalent to the claimed "receiver unit," then the applied references clearly fail to teach or suggest any equivalent to the claimed "detection device including an analyzer device and a data transmission device, . . . wherein the detection device is arranged on a chip element that is fixedly connected to the plug."

For at least the foregoing reasons, the combination of the applied references fails to render claim 1 and its dependent claims 2, 3, 5 and 7 obvious. Applicant respectfully requests that the rejection of claims 1-3, 5 and 7 be withdrawn.

CONCLUSION

In light of the foregoing, Applicant respectfully submits that all pending claims 1, 2, 3, 5 and 7 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

KENYON & KENYON

 (R. NO. 36,197)

Dated: September 27, 2005

By: JONK LEE for Gerard Messina

Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646